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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,065	08/18/2003	Bradley Berman	KING. 004CIP1	4199

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/643,065	BERMAN, BRADLEY	
	Examiner	Art Unit	
	ROBERT MOSSER	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 February 2009 has been entered.

Terminal Disclaimer

The terminal disclaimer filed on October 9th, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,620,045 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-36** and **43** rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a claimed process to be considered statutory it must be: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-

eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process.

The above cited method type claims fail to provide a tie to a particular machine or apparatus central thereto or operable to cause the transformation thereof.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1-43** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for altering the odds of achieving a bonus activity during game play, does not reasonably provide enablement for altering the odds of achieving bonus game play without effecting the odds of base game payout. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

The specification (included the applicant's cited portion) does not describe the effect of the alteration of odds for achieving a bonus game without effecting the odds of the base game payout accordingly this feature is not enabled in the specification as originally filed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-16, 18-35,** and **37-43** are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (USP 5,848,932).

The pending claim as presented address the exchange of player assets (winnings) in a base gaming activity for an increased odds of receiving a bonus activity. As broadly claimed the present invention encompasses the exchange player winnings during a round of play for a Double-or-Nothing type game feature wherein the player elects to wager their winnings acquired during a first game event in order to participate in a second game event. While such a teaching and correspondence thereof presumes that there is no opportunity to receive a bonus event in absence of receiving the player assets the pending claims do not necessitate an opportunity for the player to receive the bonus event in the absence of a player risking their winnings.

Claims **1-2, 4, 9, 13-15, 18, 20-22, 27-29,** and **37-43** : Adams teaches a method for gaming activity including a video based slot base game activity and a bonus game activity alternatively described as a Double-or-Nothing event, and further comprising:

receiving an indication from the player to trade player assets for an increased odds of participating in a bonus activity relative to the odds of providing the bonus

activity during normal play (without impacting the payout odds of the standard gaming activity), through allowing the player to elect to risk game winnings for participation in a Double-or-Nothing game event (Figs 2-3, Col 2:42-46, 8:40-49);

receiving an indication of an amount of player assets offered by the player for the trade (described as the player may wagering their winning in the above citation);

executing the trade by accepting the player assets offered for trade and altering the odds of participating in the bonus activity responsive thereto (through providing the double or nothing game feature described in the above citation); and

presenting the player an opportunity to participate in the bonus activity at the altered odds (wherein the odds 100% for the election to participate in the feature and 0% during the standard gaming activity).

Claims **3,** and **19**: In addition to the above, Adams teaches providing the player with a "direct chance" during each game play to participate in a bonus game as determined by the disclosed players selective utilization of the Double-or-Nothing event which the player "may" choose to employ as cited above.

Claims **5-8,** and **32-35**: In addition to the above, Adams teaches receiving an unsolicited player request initiated by the player and the gaming activity for allowing the player to selectively employ the Double-or-Nothing game feature as cited above. With relation to whether or not the request is initiated by the gaming activity or the player, the request is viewed as mutual event between the player and the gaming activity as both

the player and the gaming device must respectively be willing to place and accept a given Double-or-Nothing wager.

Claims **10-11**: In addition to the above, Adams teaches allowing a player to place a wager prior to the commencement of the rotation of the game reels and responsive thereto the display of a winning event enables the player to risk the winnings on the Double-or-Nothing game feature as cited above.

Claims **12**, and **24**: In addition to the above, Adams teaches allowing a player to "double-up" feature through the inclusion of a Double-or-Nothing game feature associated with the winnings of the standard gaming activity as cited above.

Claim **16**: In addition to the above, Adams teaches utilizing player assets acquired through game play through the risking of winnings as described in the above presented citations.

Claims **23, 25**: In addition to the above, Adams teaches providing a payout result corresponding to a player participation in a bonus/secondary event through the inclusion of the Double-or-Nothing game feature as cited above. The claimed result being provided to the player at a frequency reflective of the trade value is understood as being encompassed through the prior art enablement of player selective participation.

Claim **26**: In addition to the above, Adams teaches accepting trade value according to pre-configured criteria of accepting wagers derived from the winnings of a standard gaming activity as cited above.

Claims **30-31**: In addition to the above, Adams teaches providing the Double-or-Nothing game feature without requiring or prohibiting further operation of standard gaming activity thereafter.

Claim **38**: In addition to the above, Adams teaches that the use of video displays representation of slot reels is known in the art as cited above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **17** and **36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams (USP 5,848,932).

Adams teaches the invention as presented above however, is silent regarding the incorporation of allowing the player to select from multiple bonus game types. The Examiner gives Official Notice that including a plurality of selectable bonus games and allowing a player to select their bonus game type from a plurality of bonus games is old and well known in the art of gaming. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the multiple player selectable bonus games as into the invention of Adams in order to provide the player with variety in their gaming experience thereby adding to the player's enjoyment and excitement.

Response to Arguments

Applicant's arguments with respect to claims 1-43 and amendments presented therewith have been considered but are moot in view of the new ground(s) of rejection.

Specifically the applicant's arguments are directed to the newly presented claim features restricting the effect of the increase odds from the payout of the standard gaming activity. Though the amendment raises issues regarding scope of enable in the application as originally filed, these limitations have been addressed through the application of Adams as presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

/R. M./
Examiner, Art Unit 3714